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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/914,129

08/23/2001

Yoshitaka Mitui

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513

7590

10/12/2004

WENDEROTH, LIND & PONACK, L.L.P.

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SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

HINDI, NABIL Z

ART UNIT

PAPER NUMBER

2655

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding. -

Office Action Summary

Application No.

09/914,129

Applicant(s)

MITUI ET AL.

Examiner

NABIL Z HINDI

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 13-16, 18-21, 23-25 and 27-30 is/are rejected.
- 7) ☒ Claim(s) 5, 9-12, 17, 22, and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

In response to applicant's amendment dated August 18, 2004, the following action is taken:

After further review of the prior art of record (Oshima et al. the following action is taken:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-8, 13-16, 18-21, 23-25 and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Oshima et al (6266299).

The independent claims are merely drawn to using the disk ID in addition to the well established water mark in protecting the disk content. The water mark containing a disk ID and a copy attribute to protect the disk content. The reference Oshima et al discloses the use of an optical disk DVD recording and reproducing apparatus wherein the disk having copy attribute embedded as a water mark thereon (BCA). The water mark further includes a disk ID in order to protect the data content as cited in column 35 lines 35-39). The reference further discloses the use of a water mark in addition to the disk ID in protecting the data on the disk for the purpose of preventing illegal disk duplication as shown in fig s 32 and 41 showing the water make and comparing the disk ID stored into a data base in protecting the data content. The watermark BCA having a copy attribute "a first recording possible identifier" as cited in column 39 lines 33-40)

With respect to the limitations of claims 2, 3, 7, 14, 19 and 24. The reference discloses the use of a watermark as a BCA area on a disk having a disk ID and a copy attribute in order to protect the data using an apparatus of comparing the disk ID see fig 19 showing the BCA having the manufacturer data.

With respect to the limitations of claims 4, 8, 15, 16, 20, 21 and 25. The claims are drawn to "one of". Therefore only one of the limitations need to be shown to meet the claimed invention. The use of a lot number within the barcode (BCA area) is well established within the "orange book" of the DVD disk.

Claims 5, 9-12, 17, 22, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the cited prior art shows or teaches an information quality restriction embodied with the copy attribute and the disk ID as a watermark on a disk

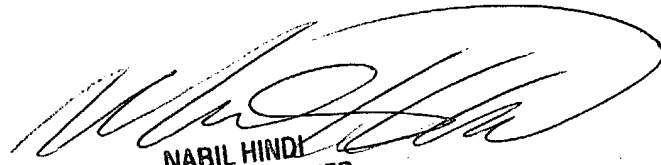
Applicant's arguments with respect to claims 1-4, 6-8, 13-16, 18-21, 23-25 and 27-30 have been considered but are moot in view of the new ground(s) of rejection.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 6608804 and 6707774 disclosing the use of a watermark on a disk for data protection.

Application/Control Number: 09/914,129
Art Unit: 2655

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Any inquiry concerning this communication should be directed to NABIL Z HINDI at
telephone number (703) 308-1555.



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